

## II. REMARKS

### A. Introduction

In the November 24, 2009 Office Action, claims 22, 24-25, 28 and 31-34 are noted as pending, and these claims are rejected based on prior art.

In summary of this Response, independent claim 22 has been amended to distinguish over the prior art, claims 24 and 25 have been amended to correct dependency in light of the prior cancellation of claim 23, and remarks are provided.

### B. Grounds for Entry of this Response Pursuant to 37 C.F.R. 1.116 and Allowance of this Application

Applicant requests entry of this Rule 116 Response because: (a) it is believed that the amendment of claims 22, 24 and 25 puts all claims into condition for allowance; (b) the amendments were not earlier presented because Applicant believed in good faith that the cited prior art did not disclose the present invention as previously claimed; and (c) the amendment of claims 22, 24 and 25 should not entail any further search by the Examiner since no new features are being added or new issues being raised.

### C. Rejection of Claims Under 35 U.S.C. § 102

Claims 22, 24, 25, 28 and 34 are rejected as being anticipated by U.S. Patent No. 6,560,916, issued to Maxim. This reference is cited for disclosing, among other recited features, "extension 44 formed at the free portion of end 16 and including 2 linear tips diverging from end 16 in opposite directions ... each linear tip having a free terminus..."

For the following reasons, it is respectfully submitted that the present invention, as recited by amended claims 22, 24, 25, 28 and 34, was neither anticipated nor rendered obvious by this reference.

The present invention is intended to allow safer, easier and more effective retention of an eye lens capsule during ophthalmologic surgery. Of course, as would be known to anyone of ordinary skill in this art, during retention the retainer cannot damage the lens capsule, lens, etc. of the eye. See, e.g., numbered paragraphs [0028] ("...the device R may be smoothly inserted into the eye..."), and [0043]-[0044] ("It was possible to fix the tips in the equatorial region without puncturing the capsule... it was confirmed that it is possible to safely and reliably carry out

cataract surgery/intraocular lens implantation.") of the present application.

Independent claim 22 recites the structure of the retaining device according to the present invention. This claim is amended herein to recite further that each tip (see members 4v, 5v, 4h and 5h of Figs. 1, 2 and 4), has a "blunt" free terminus. It is these blunt ends that allow the safe insertion of the device into the eye, safe and accurate retention of the lens capsule during the surgery and the safe removal of the device after the surgery, all without damaging the eye components.

In contrast, Maxim is a fish hook that has a "hook segment" 16 with only pointy barbs 44 at the free termini thereof. The purpose of these barbs, as with any fish hook, is to securely engage the flesh of a fish, thereby preventing the fish from coming free from the hook. As disclosed by Maxim:

The hook segment ... terminates in a hook point and at least one and preferably two barbs ... point toward the shank segment and distally... a fish engaged on the hook apparatus is pulled more deeply into the hook segment when the fishing line is in tension...the hook apparatus closes around the engaged portion of the mouth of the fish and the barbs are driven into firmer engagement of the fish. As a result, the fish becomes more securely engaged as it fights.

(Emphasis supplied) Col. 1, lines 20-35. See also Col. 6, lines 37-39 and 51-53.

Maxim nowhere includes any discussion or even a suggestion of the use of or value of blunt ends at the terminus of its hook segment 16. As a matter of fact, such a structure would be totally inconsistent with the purpose of Maxim, i.e., securely engaging the flesh of fish. Blunt ends would not engage a fish like the barbs of Maxim. Accordingly, Maxim actually teaches away from the present invention by insisting on barbs.

Since Maxim fails to disclose or teach at least one feature recited in independent claim 22, Maxim fails to anticipate or render obvious claim 22. Each of claims 24, 25, 28 and 34 depend from claim 22 and for the same reasons, are also not anticipated or rendered obvious by Maxim. Further, each of these dependent claims recites additional features which, in combination with the features of claim 22, are not anticipated or rendered obvious by Maxim.

#### D. Rejection of Claims Under 35 U.S.C. § 103

Claims 31-34 are rejected as being made obvious by the above-discussed Maxim. For the following reasons, it is respectfully submitted that the present invention, as

recited by claims 31-34, was not rendered obvious by the cited reference.

Claims 31-34 depend from amended independent claim 22. As noted above, Maxim fails to disclose or teach at least the feature of the blunt ends, and actually teaches away from blunt ends, as such a structure would not lead to “hooking” a fish. Instead the whole point of Maxim is to ensure that the fish is more securely “hooked” than the prior art by using the barbs on the movable hook segment. See, e.g., Col. 2, lines 25-31 (“these prior hooks ... slide, rock and pivot continually once a fish is engaged, causing ... the hook ... to become dislodged from the fish and sometimes from the line.”)(emphasis supplied).

Claims 31-34, which depend from claim 22, are not obvious over this reference for the same reasons. Further, claims 31-34 recite additional features which, in combination with the features of claim 22, are not taught by Maxim.

Moreover, there is no *prima facie* showing, or even any discussion in the Office Action as to why it would be “obvious” for one of ordinary skill to consider fish hook structure as being helpful or even relevant to eye surgery retaining devices. The mere fact that fish hook structure exists does not mean that its incorporation into a disparate device would be obvious.

Further, and alternatively, Maxim is simply non-analogous art. To determine if a reference is analogous, first it must be determined whether the reference is “within the field of the inventor’s endeavor” and second, assuming the reference is outside, whether the reference is “reasonably pertinent to the particular problem with which the inventor was involved.” In re Deminski, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986).

In the present case, the inventor’s endeavor is tools that assist in eye surgery and more generally devices that retain an eye lens capsule without damaging the eye. Fish hooks are hardly tools that could assist in eye surgery and by their very nature harm the fish or at least its mouth. Accordingly, the cited reference is not in the same endeavor as the claimed invention.

As for the particular problem with which the present inventor was involved, as counseled by In re Wright, 6 USPQ2d 1959, 1962 (Fed. Cir. 1988): “The problem solved by the invention is always relevant. The entirety of a claimed invention, including the combination viewed as a whole, the elements thereof, and the properties and purpose of the invention, must be considered”.

For the present invention, the problem is how to safely, easily and effectively retract the lens capsule temporarily so that eye surgery can proceed. Maxim is not concerned at all with this problem. Put simply, a fish hook in the eye? Just the thought of the damage to the eye is

enough to render such a fish hook of no interest to one of ordinary skill seeking to find a safer and easier way to retain a lens capsule.

An somewhat similar situation existed in United States Surgical Corp. v. Hospital Prods. Int'l, 701 F. Supp. 314, 334, 9 USPQ2d 1241, 1257-58 (D. Conn. 1988). Defendant argued that "analogous art" for surgical staplers was paper staplers. In United States Surgical, the respective products were far more similar than in the present case, since they served a similar purpose, i.e., they stapled, and functioned similarly. Nonetheless, paper staplers were found NOT to be "non-analogous" and therefore non pertinent prior art for the following reasons:

... the paper stapling art is not one that would lend itself to the resolution of the problems encountered in surgical stapling, or those solved by the anvil groove disclosed in claim 22... Green himself stated that there was a vast difference between paper and surgical staplers, and if he ever referred to one at all, it was only for a moment before he realized that it offered little or no guidance... He also testified that Dr. Ravitch, recognized by many as an expert in the surgical stapling field, made an attempt to utilize a paper stapler in a surgical procedure that Ravitch, himself, admitted was disastrous... the scope of the pertinent art should be limited to the surgical stapling instrument art; an art that calls for much more precision than those cited by the defense. This conclusion is consistent with Blackman's own concession that surgical stapling is a 'specialized field'.

(Emphasis supplied).

Similarly the problems that face designers of tools used for eye surgery are far different and actually opposite to those of fish hook designers. Any designer of the former wouldn't spend much time considering the applicability of the latter before concluding same was of little if any guidance and likely damaging. Any attempt to use a fish hook to retain a lens capsule would be at least as "disastrous" as the attempt made to use the paper stapler during surgery in U.S. Surgical. Further, eye surgery, calls for at least as much precision as surgical stapling and is as at least as "specialized" of a field.

In light of the above, even if fish hooks and eye surgery retainers were of a similar endeavor, which they are not, the problems encountered by designers of the latter are significantly different than the former. Accordingly, Maxim is not believed to be analogous art to the present claims.

**III. Conclusion**

In light of the above amendments and remarks, it is respectfully submitted that claims 22, 24, 25, 28 and 31-34 are now in condition for allowance.

If there are any additional fees associated with this Response, please charge same to our Deposit Account No. 19-3935.

Finally, if there are any formal matters remaining after this Response, the undersigned would appreciate a telephone conference with the Examiner to attend to these matters.

Respectfully submitted,

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